

REMARKS

The Applicant respectfully submits this Amendment And Request For Reconsideration in response to the Notice of Panel Decision of 01 July 2010, which follows the Office Action of 29 April 2010, for the above-referenced patent application.

In the present Amendment, the Applicant amends claims amend claims 1-2, 4, 6-7, 10, 12-13, 15-, 17-18, 20-21, and 32-34, and cancel claims 3, 5, 9, 11, 14, 16, 19, and 22,; no claims have been added. The Applicant respectfully requests entry of the amendment and reconsideration of the claims 1-2, 4, 6-7, 10, 12-13, 15, 17-18, 20, 21, 32-34 as revised based on the reasons presented herein.

In the Office Action of 01 July 2010, the Examiner rejected claims 1-7, 9-22 and 32-34 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In these rejections, the Examiner made reference only to claim 1. The Examiner stated merely that "**added limitation to claim 1 was not described in the specification.**" See the Office Action of 29 April 2010 on page 6 at lines 1-2.

The Applicant notes that the Examiner's remarks are sparse and there is little if any level of specificity regarding which particular limitations are thought not to be supported in the description. The Applicant respectfully submits that all claim limitations added to claim 1 are clearly supported by the description as follows:

the mobile station storing a first file for use with a voice call application of the mobile station, the first file including a telephone number which is utilized for identifying or contacting the user in the voice call application; **[see e.g. page 20 at lines 13-16: "Advantageously, various user-specific information items that are associated with various files or applications and independently stored and maintained as separate items in the mobile station are automatically**

combined..."; see also e.g. FIG. 4 which shows files/applications 404, 406, 408, and 410 stored in the mobile station, where the files/applications include the user-specific items, and the description on page 16 at lines 9-32 to page 7 at lines 1-5; see also e.g. page 1 at lines 18-23: "[v]arious user-specific information items associated with these applications (a user name, a telephone number, an e-mail address, etc.) are independently stored and maintained as separate items in the mobile station. Since these items are independently stored and maintained, it is often difficult for the end user or subscriber of the mobile station to personally manage or communicate this information as a whole."]

the mobile station storing a second file for use with an e-mail communication application of the mobile station, the second file including an e-mail address which is utilized for identifying or contacting the user in the e-mail communication application; **[same as above]**

In the same Office Action of 29 April 2010, the Examiner rejected claims 1-22 and 32-34 under 35 U.S.C. § 103(a) as being obvious over Jin (U.S. Patent Application Publication No. US2002/0084888A1) in view of Minborg (U.S. Patent No. 6,977,909). In response, the Applicant respectfully disagrees with the Examiner's rejections, especially in light of the present claim amendments, and submits that all pending claims 1-7, 9-22, and 32-34 as revised are allowable over the prior art for at least the following reasons.

In order for claims to be properly rejected under 35 U.S.C. § 103(a), the prior art in combination must teach or suggest each and every limitation of the claims.

When determining whether a claim is obvious, an examiner must make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, "obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

Ex Parte Wada and Murphy, Appeal No. 2007-3733, Bd. Pat. App. & Inter., January 14, 2008. Because at least one limitation in each claim is not taught or suggested by the Examiner's asserted combination of art, the rejection the claims cannot be maintained.

For one, the Applicant respectfully submits that the Examiner is in error for relying on the Jin reference, which clearly fails to teach or suggest the claimed "automatic" grouping of user specific information items, but rather describes a "manual" process for the user/manual entry of data.

All pending claims 1-2, 4, 6-7, 10, 12-13, 15, 17-18, 20, 21, 32-34 as now revised are directed to techniques involving the "**automatic**" grouping of user-specific information items (specifically, a telephone number and an e-mail address) into an **e-mail message** "in response to detecting a selection of an option to add the user-specific information items."

Thus, the specific "automatic" grouping actions include "reading" a telephone number from a first file for a voice call application and "storing" it in the e-mail message, and repeating these acts for an e-mail address read from a second file (i.e. "reading" the e-mail address from the second file for a e-mail communication application and "storing" it in the e-mail message as well). As claimed, all of these grouping actions are performed "automatically" in response to the detection of the selection of the option. See e.g. pending claim 1 of the application.

Words of a claim must be given their "plain meaning," which refers to the ordinary and customary meaning given to the terms by those of ordinary skill in the art. The ordinary and customary meaning of the term "automatic" is "*acting or operating in a manner essentially independent of external influence or control*" (see the amendment of 16 October 2009 which includes an attachment with the definition of "automatic").

When read in context of the claims, the meaning of the terminology "automatically grouping" which is performed by a "mobile station" or its

"processor" means that the claimed automatic grouping actions ("reading," "storing," and repeating) are performed by the mobile station or processor in a manner independent of the user of the mobile station. Put another way, it means that these actions are performed without user or manual intervention. This interpretation is consistent with the "automatic grouping" operation described in the specification. See e.g. FIG. 5 and page 20 at lines 13-16 of the application.

In the rejection of claims, the Examiner alleges that the Jin reference teaches or suggests these claimed limitations.

Essentially, the Examiner equates the manual process of Jin, where the user manually enters or selects data via the screen (see FIG. 2, paragraph 30, FIGs. 4a-4f, and paragraphs 40-44 of Jin), with the automatic grouping of user-specific information items as claimed and described. In particular, the Examiner appreciates that in Jin the user must regularly press the "next" button or "enter" on the mobile terminal for the manual entry of data. As apparent, as Jin's process is performed in a manner that is dependent on the user of the mobile station for manual entry/selection of data; however, this is not that which is claimed and is in fact just the opposite.

As clearly apparent, Jin fails to teach or suggest any **automatic** grouping of user-specific information items (i.e. a telephone number and an e-mail address) in an **e-mail message** as claimed.

Other reasons for allowability of both the independent and dependent claims are apparent to those skilled in the art, but are not detailed herein due to the already-indicated reasons for allowability.

Based on the reasons presented herein, the Applicants respectfully request the Examiner to withdraw the rejections of pending claims 1-2, 4, 6-7, 10, 12-13, 15-, 17-18, 20-21, and 32-34, as revised. The Applicant submits that the application as amended is in a condition suitable for allowance.

Respectfully submitted,

/John J. Oskorep/

Date: 21 September 2010

JOHN J. OSKOREP
Reg. No. 41,234

JOHN J. OSKOREP, ESQ. LLC
ONE MAGNIFICENT MILE CENTER
980 N. MICHIGAN AVENUE, SUITE 1400
CHICAGO, ILLINOIS 60611 USA
Telephone: (312) 222-1860
Fax: (312) 475-1850